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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,946	02/08/2001	Yves Malecot	5418	6110

7590

04/02/2002

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EXAMINER

OCAMPO, MARIANNE S

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,946

Applicant(s)

MALECOT ET AL.

Examiner

Marianne S. Ocampo

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The following has been listed in the specification : FR documents 2,624,397 and 2,554,799, and WO publication 96/05133.

Specification

2. The disclosure is objected to because of the following informalities: the words "case" and "casing" had both been used to designate the structural element indicated by reference character 12, as in page 5, lines 2, 3, 9 and 11. Only one of these names should be used in order to avoid confusion and provide consistency throughout the disclosure.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 25 recites the limitation "the filter system" in line 2. There is insufficient antecedent basis for this limitation in the claim. Is the "filter system" different from that of the filter element? What structural elements are being added or claimed by this "filter system"? For examination purposes, the examiner has considered as the filter system being the filter element which comprised of the housing (casing) and filter paper element.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13 - 20 and 24 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom (US 3,468,425) in view of McBurney et al.(US 2,955,067).

7. Concerning claim 13, Engstrom discloses a filter element for filtering a fluid in a filter system comprising a cylindrical case (1), the filter element also comprising a filter paper material (7, 12) in sheet form configured to constitute a tubular cylinder inside the case (1) in a manner to partition an outer radial part (outer region which surrounds outer sides/surfaces of the filter element 7) from an inner radial part (inner region in which the filtered fluid is being collected) wherein a fluid (such as lubricating oil) is able to move across the filter element (7) in a substantially centripetal direction and the filter element (7, 1) is devoid of a central core, as in figs. 1 - 6 and 8. However, Engstrom fails to disclose the paper material being absorbent. McBurney et al. teach a filter element formed of an absorbent paper material for the filtering of fluids, particularly lubricating oils, as in col. 1, lines 15 - 33. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the material of construction of the filter element of Engstrom in lieu of (from that of regular filter paper material) to the absorbent filter paper material taught by McBurney et al., in order to provide an improved filter element having the ability to not only filter undesirable particulates (such as dirt, metallic particles, etc). from lubricating oils but also have the ability to remove acidic impurities therefrom, which could be damaging (corrosive) to engine parts and machinery for which the oil would be used into.

8. With regards to claim 14, Engstrom discloses the tubular cylinder formed by filter element (7) having a mean inside diameter greater than $1/20$ of a mean outside diameter of the tubular cylinder, as in figs. 1 – 3.

9. Regarding claim 15, Engstrom also discloses the mean inside diameter being greater than $1/4$ of the mean outside diameter, as in figs. 2 – 3.

10. Concerning claim 16, Engstrom discloses the mean inside diameter being substantially $1/3$ the mean outside diameter, which is in the claimed range of between $1/3$ and $1/2$ the mean outside diameter, as in figs. 2 – 3.

11. With respect to claim 17, although Engstrom, as modified by McBurney et al, does not disclose the exact dimensions of the mean inside diameter (cylinder), particularly being greater than 25 mm, it is considered by the examiner that the fluid filter element of Engstrom as modified by McBurney, would not perform differently from the claimed device, and according to case law, *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984)], cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984), a prima facie case of obviousness exists when (The Fed. Circuit held that where) the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

12. Regarding claim 18, Engstrom discloses the tubular cylinder (7) having an inside wall which is cylindrical in shape and has circular cross-sectional shape, as in figs. 1 – 3.

13. With regards to claim 20, Engstrom discloses the paper material (used as filter element 7) being a strip which is a continuous single sheet wound to provide the tubular cylinder, as in figs. 4 and 8. It is considered obvious upon combination of the teachings of Engstrom and McBurney, that the single continuous sheet of paper material wound to become a tubular cylinder would be an absorbent paper material.

14. With respect to claim 24, McBurney et al. further teach the absorbent paper being cellulose cotton (i.e. cellulosic paper), as in cols. 1 – 6.

15. Concerning claim 25, Engstrom as modified by McBurney et al., teach the filter element (system) being constructed and arranged to filter automotive engine oil (i.e. lubricating oil), as in col. 1 of both patents.

16. Regarding claim 19, Engstrom further discloses the filter element further comprising at least one polarizing positioning means (in the form of the spring spider 6 and tubular extension sleeve 9), as in fig. 1.

17. Claims 21 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engstrom and McBurney et al., as applied to claim 13 above, and further in view of White (US 4,469,598).

18. With regards to claim 21, Engstrom as modified by McBurney et al., fail to disclose the absorbent paper being comprised of a series of sheets interlaced together to provide the tubular cylinder. White teaches a filter element being formed of an absorbent paper material comprised of a series of sheets (20, 22) interlaced (bonded) to provide a tubular cylinder of pleated filter element, as in figs. 2 – 4. It is considered obvious to one of ordinary skill in the art to modify the material of construction (i.e. absorbent paper) of the filter element of Engstrom as modified by McBurney et al., by adding the embodiment taught by White, in order to provide an alternative design and effective filter element for the filtration of fluids.

19. Concerning claims 22 – 23, White further teaches each of the sheet (20 or 22) comprises several plies or layers (30 – 40), as in fig. 4. The same motivation applied above in claim 17 applies here. Furthermore, making the filter element/paper to have several plies would make the filter element thicker and therefore provide a better and more efficient filter element which has greater capability to absorb more moisture (water) without getting degraded easily.

Art Unit: 1723

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 1,411,975 (Matson), 3,646,882 (Keating), 4,289,513 (Brownhill et al.), 5,103,434 (Furrow), 4,857,195 (Brownell et al.) 5,413,712 (Gewiss et al.) and 3,692,186 (Marzocchi).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

23. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.S.O.
March 25, 2002

M. Savage
MATTHEW O. SAVAGE
PRIMARY EXAMINER